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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,107	03/03/2004	Michelle Grandy	20119-0003	4100

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EXAMINER

SZUMNY, JONATHON A

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 03/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/792,107

Applicant(s)

GRANDY, MICHELLE

Examiner

Jon A Szumny

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

This is the first office action for application number 10/792,107, Decorative Hanging Wastebasket, filed on March 3, 2004.

### *Priority*

Domestic priority of application number 60/451,739, filed on March 4, 2003 is acknowledged.

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “any combination of the plate, the ring piece, and the first mounting piece being detachable” (from claim 3) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show the “first mounting piece being detachable from the ring piece” as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). The applicant must not add any new matter. It appears from the drawings that the first mounting piece and ring piece are simply one-piece with each other, and in no way detachable.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be

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removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In the abstract, line 2, "is provided" should be removed.

The disclosure is objected to because of the following informalities:

In paragraph 19, lines 2-4, it is not understood how the plate, ring piece and first mounting piece can be detachable from the basket holder. The plate, ring piece and first mounting piece ARE the basket holder. How can something be detachable from itself?

In line 5, "230" should be --220--.

Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 3, the specification merely recited first that the "plate, ring piece, first mounting piece are detachable from the basket holder" (this is ambiguous in itself), and that the "first mounting piece may be detachable from the ring piece." In no way did the written description specifically describe or the drawings show exactly how "any combination of the plate, the ring piece, and the first mounting piece are detachable," as specified in claim 3.

Therefor, the Examiner will not attempt to apply prior art against claim 3.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claims 2-10 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, it is not clear if the “storage unit” and “surface” are being recited *functionally* or *positively*. Claim 1 recites the former (“...for securing a storage unit to a surface...”), but then claim 2 recites the storage unit and surface positively (“a plate that attaches to the surface” and “a ring piece attached to the plate that receives the storage unit...”); a similar situation exists in claim 9. The applicant must make it clear whether the “storage unit” and “surface” are being recited *functionally* or *positively*. For the purposes of this office action, the Examiner will assume the “storage unit” and “surface” are being recited merely *functionally*.

Claims 10 and 14 recite the limitations “the platform” and “The method” in lines 2 and 1, respectively. There is insufficient antecedent basis for these limitations in the claims. It appears claims 10 and 14 were meant to depend from claims 9 and 13, respectively, and the Examiner will assume this is so for the purposes of this office action.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-6 and 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent number 2,074,248 to Barbour.

Regarding claims 1, 2, 4-6, 9, 10 and 12, Barbour '248 discloses an apparatus (figures 1-2) comprising a holder and a cover/concealing means (17) attached to the holder, wherein the cover is inherently sized to conceal in part a storage unit, wherein the holder comprises a plate/securing means (5), a ring piece/platform/hanging means (1) attached to the plate, and a first mounting piece (13,23) attached to the ring piece, wherein the cover comprises a second mounting piece (18-22,27-29) connected to the first mounting piece, wherein the second mounting piece is detachable from the first mounting piece as well as the cover, wherein the apparatus includes a fencer (8),

With respect to claim 11, Barbour '248 teaches an apparatus (above) comprising a storage unit (1) including a first mounting piece (5) connected to a surface and a second mounting piece (13) connected to a cover (17).

Regarding claims 13 and 14, Barbour '248 inherently teaches a method of securing a storage unit (1) to a surface, and concealing in part the storage unit (via 17), wherein a wastebasket (3) is secured on a wall (a "wastebasket" is defined in Merriam Webster's Collegiate Dictionary - 10<sup>th</sup> Edition as "a receptacle for refuse...", so clearly, 3 is a receptacle that could hold refuse).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barbour '248.

Barbour '248 teaches the previous invention wherein the second mounting piece includes a slot (24) for receiving the first mounting piece, but fails to teach vice versa. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have reversed the parts so that the first mounting piece include a slot for receiving the second mounting piece since a reversal of parts is held to be an obvious expedient. See *In re Gazda*, 219 F.2d 449, 104 USPQ 400 (CCPA 1955).

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Coderre et al. '144, Corke et al. '354, Messick '498, Stanley '032, Cotney '126, Yakulis, Jr. et al. '523, Roy et al. '733, Brown '587 and Maznik '517 teach various apparatuses attached to a wall or surface for holding objects.

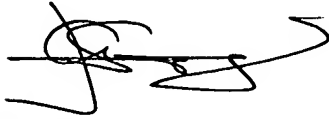
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon A Szumny whose telephone number is (703) 306-3403. The examiner can normally be reached on Monday-Friday 8-4.

The fax phone number for the organization where this application and proceeding are assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is

(703) 308-1113.

A handwritten signature in black ink, appearing to read 'Jon Szumny', with a stylized flourish at the end.

Jon Szumny  
Patent Examiner  
Technology Center 3600  
Art Unit 3632  
February 23, 2005